

Serial No. 09/537,506
Docket No. 10655.9400

REMARKS

Applicants reply to the Office Action mailed on July 5, 2005 within two months. Thus, Applicants request an Advisory Action, if necessary. The Examiner rejects claims 47-55 pending in the application. This Response amends claims 47-55. Upon entry of the foregoing amendments, claims 47-53 (2 independent claims; 9 total claims) remain pending in the application. Applicants request reconsideration in view of the above amendments and the following remarks. No new matter is included in the amendments.

Telephonic Interview

Applicants thank the Examiner for the telephone interview of August 9, 2005 during which the Office Action, the cited reference, and proposed amendments to the claims were discussed in detail.

Rejections Under 35 U.S.C. § 112

Claim 49 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states "Claim 49 recites the limitation 'the second presentment' in line 1. There is insufficient antecedent basis for this limitation in the claim. A first presentment is not previously disclosed." (page 1) Applicants respectfully traverse this rejection. However, in order to expedite prosecution, Applicants have amended claim 49. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 102(e)

Claims 47-55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Israel *et al.*, U.S. Patent Application Publication No. US 2004/0210540 A1 ("Israel"). Applicants respectfully traverse this rejection.

In the Claim Rejections section of the Office Action, the Examiner merely repeats the language of each claim and then states "see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151" with reference to the Israel reference (see Page 2). This generic rejection is repeated for each claim. In the "Response to Arguments" section of the Office Action (Pages 5-7), the Examiner recites language from the Israel reference, but the

Serial No. 09/537,506
Docket No. 10655.9400

Examiner does not apply this language to the pending claims. Rather, the Examiner states "Examiner respectfully disagrees with Applicants' characterization of the prior art" (Page 6) and then proceeds to give a lengthy characterization of Israel without showing how it teaches, discloses, suggests, or even relates to the pending claims. Applicants respectfully assert that the Examiner has not provided sufficient explanation or support for the Section 102(e) rejection of claims 47-55 by Israel.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To anticipate a claim for a patent, a single prior source must contain each of its limitations. Hybridtech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1376, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). In other words, "every limitation of a claim must **identically** appear in a single prior art reference for it to anticipate the claim." Gechter v. Davidson, 116 F.3d 1454 (Fed. Cir. 1997) (emphasis added). "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558 (Fed. Cir. 1996).

Israel teaches a system that enables adverse parties to conduct and manage a non-judicial dispute resolution. When users of the Israel system add disputes to the system, they are "prompted to select a profile classification as either a plaintiff or a defendant." (Israel Paragraph 0133) The nature of the dispute is selected by the user from a displayed general list and the nature of the dispute is a cause of action recognized by a judicial system such as a bad loan, landlord/tenant dispute, personal injury, and the like. (Israel Paragraph 0134) Thereafter, the user selects "an Opposing Party from a list" or a new Opposing Party. (Israel Paragraph 0135) Next, the user enters additional dispute information. The user is prompted to enter additional dispute information (Israel Paragraph 0139) that varies depending on the nature of the dispute. Graphic displays may be provided, such as a skeleton for identifying body parts if the dispute involves personal injury. (Israel Paragraphs 0139-0140, Figures 3 and 4)

As set forth in more detail below, the user of the Israel system does not select from a predetermined set of electronic dispute resolution templates that are available only to Issuers or from a pre-defined set of forms that are independent of a type of dispute.

Serial No. 09/537,506
Docket No. 10655.9400

Paragraph 0009 of Israel generally discloses "an electronic architecture which receives, sorts, and stores data related to non-judicial dispute resolution." This paragraph also discloses "Full range of non-judicial dispute resolution procedures includes bid-style negotiations, mediation, and arbitration." However, paragraph 0009 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0011 of Israel is a one sentence paragraph that recites "The architecture itself includes a management module, configured to receive, sort and store dispute dispute resolution data and to provide internal continuous compilation of such data and new data generated during non-judicial dispute resolution procedures." However, paragraph 0011 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0014 of Israel generally discloses "the program manager access can include a plurality of selectable actions such as, for example and not limited hereby, adding users, modifying existing user data, transferring active cases from one user to another, activating users, modifying account registration data, browsing all disputes, generating detailed dispute reports, generating summary reports of disputes, browsing dispute resolution cases, as well as other actions which are used by a manager of non-judicial dispute resolutions, and any combination of one or more of the foregoing." However, paragraph 0014 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Serial No. 09/537,506
Docket No. 10655.9400

Paragraph 0016 of Israel generally discloses "an administrative personnel access" that "enables required administrative personnel to select" from "informing the parties of disputes submitted to the system which request their response, informing users of settled disputes, marking disputes active, generating prior dispute lists, generating activity reports for the system, providing billing information, generating summary reports for any or all accounts within the system, generating audit reports to ensure that the system is functioning properly, and any other choices required of an administrative personnel, and any combination of the foregoing." However, paragraph 0016 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0035 of Israel is a one sentence paragraph that states "Other aspects of the present invention include, separately, a system for managing non-judicial dispute resolution which includes an electronic interface along with multiple types of access to an electronic architecture as described hereinabove." Thus, paragraph 0035 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0036 of Israel is a one sentence paragraph that states "The present invention also includes a method of managing non-judicial dispute resolution by providing and maintaining an electronic interface having multiple types of access to an electronic architecture as fully described hereinbefore." Thus, paragraph 0036 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Serial No. 09/537,506
Docket No. 10655.9400

Paragraph 0053 of Israel generally discloses "a party inputs data corresponding to a non-judicial dispute resolution, the system sorts, organizes and compiles the data, and enables the party to avail itself of a full range of non-judicial dispute resolution procedures." Paragraph 0053 of Israel also discloses that "the system also allows users of the system to organize data corresponding to multiple disputes." However, paragraph 0053 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0060 of Israel generally discloses "if the user is a new user to the system, they are directed to register with the system to obtain an account number, a username and a password." Thus, paragraph 0060 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0132 of Israel generally discloses "Program Users begin the process of adding a dispute by clicking on the Add Dispute icon 40 from the Program User Page." Thus, paragraph 0132 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**," as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0134 of Israel generally discloses "After selecting the appropriate profile, the user is then prompted to select at 60, from a displayed general list 59, the nature of the dispute." Paragraph 0134 of Israel also discloses that the "general nature of the dispute can be a general dispute, a bad loan, a business transaction, construction, contract, credit card, foreclosure, labor and employment, landlord/tenant, lender liability, partnership agreement, personal injury, professional liability, purchase and sale transaction, rental agreement, intellectual property,

Serial No. 09/537,506
Docket No. 10655.9400

subrogation, worker compensation, or any other cause of action recognized by a judicial system, whether in the United States or abroad.” However, paragraph 0134 of Israel does not disclose or suggest at least “selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**” as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0135 of Israel is a one sentence paragraph that discloses “the Program User is prompted by the system to select an Opposing Party at 61 from a list generated from the data stored in the management module, or a new Opposing Party whose data is not yet entered into the system.” Thus, paragraph 0135 of Israel does not disclose or suggest at least “selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**” as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0136 of Israel generally discloses “Opposing Parties are those individuals, firms or companies who have accounts with the system or who have been users of the system” and that “data on both the Opposing Party and an individual person representing that Opposing Party is retained within the management module of the system.” However, paragraph 0136 of Israel does not disclose or suggest at least “selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**” as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0137 of Israel generally discloses “if an additional dispute is added to the system for that Opposing Party, the data corresponding to that party or individual will not need to be re-entered, but rather simply selected.” However, paragraph 0137 of Israel does not disclose or suggest at least “selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and

Serial No. 09/537,506
Docket No. 10655.9400

said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0138 of Israel generally discloses "by selecting companies and firms as well as individuals within those companies and firms from a list, reports may be generated based on those Opposing Parties." However, paragraph 0138 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0144 of Israel generally discloses "if the Program User submitting the dispute wishes to use the management capabilities of the system to organize the dispute data," they "can simply submit the above-entered information to the management module." Thus, paragraph 0144 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0145 of Israel generally discloses how the Program User can review the entered data and submit "the data to the management module at 64 for identification, sorting, organizing and storing by clicking on the Submit icon." However, paragraph 0145 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0150 of Israel generally discloses "the opposing party must have their access code and dispute code" in order to access the system. Paragraph 0150 of Israel also discloses how to access the system via a web-site. However, paragraph 0150 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute

Serial No. 09/537,506
Docket No. 10655.9400

resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Paragraph 0151 of Israel generally discloses "Upon entry of a valid access code and a dispute code, the management module will send all dispute resolution data corresponding to these input codes to the reckoning module for application of the pre-selected criteria." However, paragraph 0151 of Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers,**" as similarly recited by amended independent claims 47 and 51. (emphasis added)

Accordingly, Israel does not disclose or suggest at least "selecting, by said Issuer, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute** and said predetermined set of dispute resolution templates are **available only to Issuers**" as recited by amended independent claim 47, or "selecting, by said Issuer, one of said pre-defined set of Issuer forms at said first access terminal, wherein said pre-defined set of Issuer forms is **independent of a type of said post-transactional dispute** and said pre-defined set of Issuer forms are **available only to Issuers**" as recited by amended independent claim 51. (emphasis added)

Dependent claims 48-50 and 52-55 variously depend from independent claims 47 and 51, so dependent claims 48-50 and 52-55 are differentiated from the cited reference for at least the same reasons as set forth above, as well as in view of their own respective features.

Serial No. 09/537,506
Docket No. 10655.9400

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 47-55, fully comply with 35 U.S.C. §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814, including any required extension fees.

Date: 6-Sept.-2005

Respectfully submitted,
By: David Caplan
David Caplan
Reg. No. 41,655

SNELL & WILMER, L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202
Direct: (602) 382-6284
Fax: (602) 382-6070
Email: dcaplan@swlaw.com